

ESTTA Tracking number: **ESTTA756711**

Filing date: **07/06/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	La Aurora SA
Granted to Date of previous extension	07/06/2016
Address	Parque Industrial Tamboril Carretera Santiago Tamboril Km 5 Guazumal, 00000 DOMINICAN REPUBLIC
Attorney information	Frank Herrera H New Media Law 224 Datura Street Suite 101 West Palm Beach, FL 33401 UNITED STATES fherrera@hnewmedia.com Phone:561-841-6380

Applicant Information

Application No	86746436	Publication date	03/08/2016
Opposition Filing Date	07/06/2016	Opposition Period Ends	07/06/2016
International Registration No.	NONE	International Registration Date	NONE
Applicant	OETTINGER DAVIDOFF AG HOCHBERGERSTRASSE 15 BASEL, 4002 SWITZERLAND		

Goods/Services Affected by Opposition

Class 034. First Use: 2015/05/29 First Use In Commerce: 2015/05/29


All goods and services in the class are opposed, namely: Tobacco products, namely, cigars, cigarillos, smoking tobacco; smokers' articles, namely, cigar cutters, non-electric cigar and cigarette lighters not of precious metal, cigar humidifiers, cigar boxes with humidifiers; tobacco boxes, cigarcases, ashtrays for smokers and matches

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	86639591	Application Date	05/22/2015
Registration Date	NONE	Foreign Priority	NONE

		Date	
Word Mark	AURORA BARREL AGED		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 034. First use: First Use: 2008/03/30 First Use In Commerce: 2008/03/30 Cigars		

Attachments	86639591#TMSN.png(bytes) La Aurora v Davidoff NOP 7-6-16f.pdf(119375 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/FH/
Name	Frank Herrera
Date	07/06/2016

**UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

OPPOSITION NO.: TBA

LA AURORA, S.A.)	
)	
Opposer,)	
v.)	
)	
OETTINGER DAVIDOFF, A.G.)	
)	
Applicant.)	
_____	/	

NOTICE OF OPPOSITION

COMES NOW, Opposer, La Aurora, S.A., (“La Aurora”) and files this Notice of Opposition against Applicant Oettinger Davidoff, A.G.’s (“Davidoff”) federal trademark Application No. 86/746,436 for the mark “**AMERICAN BARREL AGED and Design**” for the following legal and factual grounds:

1. On September 3, 2015, Davidoff filed an application to register the mark “**AMERICAN BARREL AGED and Design**”, for use in connection with “[t]obacco products, namely, cigars, cigarillos, smoking tobacco; smokers’ articles, namely, cigar cutters, non-electric cigar and cigarette lighters not of precious metal, cigar humidifiers, cigar boxes with humidifiers; tobacco boxes, cigar cases, ashtrays for smokers and matches” in International Class 34.

2. Within that trademark application, Davidoff claimed that all of the goods listed were in use at least as early as May 29, 2015. As part of that application, Davidoff voluntarily entered a disclaimer of “BARREL AGED” with full knowledge that La Aurora used that phrase exclusively in the marketplace since at least as early as March 30, 2008.

3. La Aurora is a corporation organized and existing under the laws of the Dominican Republic.

4. Davidoff is a corporation organized and existing under the laws of Switzerland.

5. Both La Aurora and Davidoff offer premium cigars in United States commerce.

6. La Aurora and Davidoff are direct competitors.

7. La Aurora has a real interest in this proceeding and will be harmed if the application matures to registration.

8. Specifically, La Aurora will be harmed by this application because Applicant's mark is confusingly similar to La Aurora's "**AURORA BARREL AGED**" in sight, sound, and meaning.

9. La Aurora's use of "**AURORA BARREL AGED**" is distinctive of cigars and related goods or has otherwise attained acquired distinctiveness through exclusive and long-term use in commerce.

10. La Aurora was the exclusive user of "**AURORA BARREL AGED**" and "**BARREL AGED**" for at least seven (years) prior to Davidoff's claimed first use date.

11. Only one other cigar company attempted to file an application with the phrase, but those applications were filed under "intent-to-use" and are long abandoned.

	Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
1	86639591		AURORA BARREL AGED	TSDR	LIVE
2	86746476	4915819	AMERICAN BARREL AGED	TSDR	LIVE
3	86746436		AMERICAN BARREL AGED	TSDR	LIVE
4	77217846		PERDOMO BARREL AGED	TSDR	DEAD
5	77217833		BARREL AGED	TSDR	DEAD

12. Davidoff also recently obtained Registration No. 4,915,819 for “**AMERICAN BARREL AGED**” that will soon be the subject of a cancellation proceeding. It is foreseen that the proceedings will be consolidated at the appropriate time.

13. Davidoff’s use of “BARREL AGED” is junior to La Aurora’s use.

14. Davidoff’s aggressive marketing campaign of its “**AMERICAN BARREL AGED and design**” branded cigars has caused actual confusion in the marketplace, and will continue to cause confusion.

15. Davidoff’s voluntary disclaimer of “BARREL AGED” has caused the Trademark Office to require La Aurora to enter a similar disclaimer.

16. This requirement for a disclaimer is not appropriate because La Aurora’s use of “BARREL AGED” is distinctive or otherwise has achieved acquired distinctiveness through long-term use predating Davidoff’s use by over seven (7) years.

17. La Aurora’s rights in “**AURORA BARREL AGED**” are being harmed and will continue to be harmed if Davidoff’s application matures to registration.

COUNT I – LIKELIHOOD OF CONFUSION

18. La Aurora alleges and incorporates the foregoing allegations as if fully stated herein.

19. Davidoff’s “**AMERICAN BARREL AGED and design**” mark is likely to be confused with La Aurora’s “**AURORA BARREL AGED**” mark for cigars.

20. There is a high level of similarity between the marks in their entirety as to appearance, sound, connotation and commercial impression.

21. The marks are visually similar since both marks contain three words and the first word of both marks starts with an A.

22. The marks may sound the same when spoken by a consumer requesting the cigars from a cigar retailer.

23. The relatedness of the goods, as described in the applications, are identical or nearly identical.

24. The similarity of established, likely-to-continue trade channels is identical.

25. There is no significant number of similar marks in use on similar goods.

26. There does not exist a valid consent agreement between the La Aurora and Davidoff for the use of "BARREL AGED".

27. La Aurora is being harmed and will continue to be harmed by Davidoff's application for "**AMERICAN BARREL AGED and design**".

WHEREFORE, Opposer La Aurora prays that Application No. 86/746,436 be denied registration and that this Notice of Opposition be granted.

Dated this 6th day of July of 2016

s/FRANK HERRERA
Frank Herrera
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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Notice of Opposition was served on:

Debra Deardourff Faulk, esq.
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by mailing said copy on July 6th, 2016, via First Class Mail, postage pre-paid.

s/FRANK HERRERA
Florida Bar No. 494801